

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 4-11, 17, 20-22, 30-36, 39, 42-50 and 52-54 are pending. No claims are amended. Claims 1, 8, 17, 30, 34, 39, 46 and 50 are independent.

In the Official Action, claims 1, 4-11, 17, 20-22, 30-36, 39, 42-50 and 52-54 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lamkin (U.S. Patent Pub. No. 2005/0251749, now U.S. Patent No. 7,545,515).

Briefly recapitulating, claim 1 is directed to

A method for reproducing contents information in a device, comprising:

a) synchronously reproducing data read from a recording medium and contents information downloaded from a contents provider server connected via a network interface, said contents information being associated with the data read from the recording medium;

b) sending a command for requesting re-sending of specific contents information to the contents provider server, with reference to specific information contained in normally reproduced last contents information, if reception of said contents information from said contents provider server is suspended or delayed; and

c) synchronously reproducing said specific contents information re-sent from said contents provider server in response to said command and data read from said recording medium,

wherein said specific information contained in said normally reproduced last contents information includes at least one of contents information offset information and offset information of said data read from said recording medium, and

wherein said step b) includes the steps of:

b-1) checking said specific information contained in said normally reproduced last contents information if the reception of said contents information from said contents provider server is suspended or delayed;

b-2) calculating information regarding re-synchronizable contents information based upon said checked specific information; and

b-3) generating as said command a command for requesting re-sending of specific contents information corresponding to the calculated information regarding said re-synchronizable contents information and sending the generated command to said contents provider server.

As a first point of order, Applicant submits that Lamkin is an improper reference upon which to base a rejection. A comparison of Applicant's originally filed claims and Lamkin's claims reveal that Lamkin appears to have copied Applicant's claims *verbatim*. There is no support within the specification of Lamkin for the claims of Lamkin.

Next, the current Office Action asserts that paragraphs [0047] to [0053], and [0106] to [0110] and [0115] to [0118] of Lamkin teach a) Applicant's claimed step of "sending a command for requesting re-sending of specific contents information to the contents provider server, with reference to specific information contained in normally reproduced last contents information, if reception of said contents information from said contents provider server is suspended or delayed;" and b) Applicant's claimed feature of "said specific information contained in said normally reproduced last contents information includes at least one of contents information offset information and offset information of said data read from said recording medium." Applicant traverses for the following reasons:

With respect to Applicant's claimed step of "sending a command for requesting re-sending of specific contents information to the contents provider server, with reference to specific information contained in normally reproduced last contents information, if reception of said contents information from said contents provider server is suspended or delayed" a) there is

no disclosure in Lamkin's paragraphs [0047] to [0053] about the situation of the suspension or delay of the reception of contents information from a server. Indeed, Lamkin is silent on the question of a suspension or delay situation. Thus, contrary to the Official Action, the specified paragraphs do not disclose and are not related to the feature of "sending a command for requesting re-sending of specific contents information to the contents provider server, with reference to specific information contained in normally reproduced last contents information".

Also, regarding Applicant's claimed "specification information," cited paragraph [0115] of Lamkin merely recites "The system timer (722) provides time stamps to the event generator (706) for use in determining events for synchronization or controlled playback." Otherwise, there is no mention of the "time stamp" in the specification of Lamkin. However, paragraph [0115] of Lamkin does describe Applicant's claimed feature of "said specific information contained in said normally reproduced last contents information includes at least one of contents information offset information and offset information of said data read from said recording medium."

Finally, with respect to Applicant's claimed steps b-1), b-2), and b-3), the rejection only cites to Lamkin's claims. Applicant again directs the Examiner to In re Benno, 226 USPQ 683, 786 F.2d 1340, which notes, *inter alia*:

The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding....Danti's claim 1 does not disclose any structure additional to what the Danti specification discloses. For the above reasons, we hold that the board erred in relying on Danti's claim 1 in deciding that appellant's claims would have been obvious from that reference alone and also in reaching that conclusion.

In other words, it is improper to base a rejection solely on the contents of a reference's claims. The rejection must be based on the disclosure of the specification, not merely the claims. Thus, the rejection is patentably improper. In view of *In re Benno*, if the Lamkin reference is again applied as a basis of rejection, Applicant requests specific citations to Lamkin's specification, not claims, for each and every feature recited in Applicant's claims. Absent such a citation, it is not permissible to rejection Applicant's claims.

Applicant submits that independent claims 8, 17, 30, 34, 39, 46 and 50 patentably define over Lamkin for reasons similar to those presented above relative to independent claim 1.

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Lamkin does not disclose or suggest all of the features recited in claims 1, 8, 17, 30, 34, 39, 46 and 50, Lamkin does not anticipate the invention recited in claims 1, 8, 17, 30, 34, 39, 46 and 50, and all claims depending therefrom.


CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael E. Monaco, Reg. No. 52,041, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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